

Applicant acknowledges with appreciation the Examiner's indication of allowable subject matter in claims 4, 6, and 7.

Claims 2-14 and 16-37 are currently pending. Claims 22-37 have been withdrawn from consideration by the Examiner. Applicants respectfully request reconsideration of the outstanding objection and rejection, and allowance of all the claims pending in the present application.

The Examiner has objected to claim 12 under 37 C.F.R. § 1.75(c) as being in improper dependent form for failing to further limit the scope of a previous claim. However, Applicants note that claim 2 recites a flexible tube for an endoscope in which, inter alia, "the intermediate layer of the outer cover has a higher elasticity than the inner and outer layers". Claim 12 recites the flexible tube according to claim 2 "wherein the intermediate layer of the outer cover is formed of a material having higher elasticity than that of the outer layer". Since claim 2 requires that the *intermediate layer* has a higher elasticity than the *inner and outer layers*, while claim 12 requires that the *material* of the intermediate layer has a higher elasticity than that of the *outer layer*, claim 12 sets forth limitations that are not set forth in claim 2. Therefore, claim 12 further limits the scope of previous claim 2. Accordingly, in view of the above noted remarks, it is believed that the objection to claim 12 is inappropriate, and Applicants respectfully request reconsideration and withdrawal of the outstanding objection.

The Examiner has rejected claims 2, 3, 5, 8-14, and 16-21 under 35 U.S.C. § 102(e) as being anticipated by SUGIYAMA et al. (U.S. Patent No. 6,458,075) or alternatively under 35 U.S.C. § 103(a) as being unpatentable over SUGIYAMA et al. The Examiner takes the position that the SUGIYAMA et al. patent discloses a flexible tube having an outer cover formed into a laminate structure including an intermediate layer 30A having a higher elasticity than the outer layer 30B and the inner layer 20. Further, the Examiner takes the position that the inner layer 20 is inherently less flexible than the intermediate layer 30A since the inner layer 20 includes both the material from the intermediate layer 30A and metallic braided wire. The Examiner contends that, alternatively, it would have been obvious to make the intermediate layer more flexible than the inner layer to facilitate bending.

As an initial matter, it is pointed out that SUGIYAMA et al. does not qualify as prior art against the present application for purposes of a rejection under 35 U.S.C. § 103(a) due to common ownership with the present application. See 35 U.S.C. § 103(c). It is noted that the SUGIYAMA et al. patent issued from U.S. Application No.09/559,411 which was filed on April 26, 2000, prior to the filing date of the present application on May 4, 2001, and prior to the 35 U.S.C. § 119 priority date of the present application which is May 8, 2000. However, the SUGIYAMA et al. patent did not issue until October 1, 2002, which is after the filing date of the present application. Therefore, and as applied by the Examiner, the SUGIYAMA et al. patent has been applied in the Official Action as a 102(e)/103 reference.

As pointed out above, SUGIYAMA et al. is not available for use as prior art against the present application for purposes of a rejection under 35 U.S.C. § 103(a) due to common ownership. Present Application No. 09/848,301 and the SUGIYAMA et al. patent, U.S. Patent No. 6,458,075, were at the time the invention of the present Application No. 09/848,301 was made, owned by ASAHI KOGAKU KOGYO KABUSHIKI KAISHA (now PENTAX Corporation). It is noted that an Assignment of the invention of the present Application No. 09/848,301 to ASAHI KOGAKU KOGYO KABUSHIKI KAISHA was recorded at Reel 011952, Frame 0673. Therefore, the rejection of claims 2, 3, 5, 8-14, and 16-21 under 35 U.S.C. § 103(a) as being unpatentable over SUGIYAMA et al. is at least improper due to the unavailability of the SUGIYAMA et al. patent as prior art under 35 U.S.C. § 103(c). Accordingly, the withdrawal of such rejection is respectfully requested.

Further, Applicants note that the SUGIYAMA et al. patent fails to show each and every element recited in independent claim 2. In particular, claim 2 sets forth a flexible tube including, inter alia, “an elongated tubular core body” and an outer cover “which is formed into a laminate structure composed of at least three layers” including inner, intermediate, and outer layers in which “the intermediate layer of the outer cover has a higher elasticity than the inner and outer layers so that the intermediate layer functions as a cushioning between the inner layer and the outer layer”. However, the SUGIYAMA et al. patent discloses a flexible tube including a helical tube 10 and a reticulate tube 20 formed of braided wire,

which is covered by a jacket 30 on its outer surface. The jacket 30 is formed of a layer 30A and an outermost layer 30B. The Examiner has read the claimed inner layer on the combination of the reticulate tube 20 with material of the layer 30A within the mesh openings; the intermediate layer as the layer 30A; and the outer layer as the layer 30B.

However, contrary to the Examiner's assertions, (the braided wire reticulate tube 20 of the SUGIYAMA et al. device forms a portion of the claimed "elongated tubular core body", and does not form a portion of the "outer cover".) In the SUGIYAMA et al. device, the helical tube 10 and the braided wire reticulate tube 20 form the "elongated tubular core body"; while the jacket 30 forms the "outer cover". In this regard, as stated in the SUGIYAMA et al. patent, the jacket 30 covers the helical tube 10 and the reticulate tube 20 (see column 3, lines 3-8). Further, in column 3, lines 25-34, SUGIYAMA et al. discloses that the jacket 30 is formed by an extrusion molding operation in which material forming the jacket 30 is heated to cover the reticulate tube 20 and then cooled. Additionally, as shown in figure 2, the helical tube 10 and the reticulate tube 20 are initially provided as a unit, and then the jacket 30 is formed over the helical tube 10 and reticulate tube 20 combination. Thus, the jacket 30 forms an outer cover over the helical tube 10 and the reticulate tube 20. In the SUGIYAMA et al. device, the reticulate tube 20 does not form a portion of the claimed "outer cover". Therefore, the "outer cover" of the SUGIYAMA et al. device includes only the jacket 30, which, as recognized by the Examiner, is formed only of layers

30A and 30B. Accordingly, since the “outer cover” of the SUGIYAMA et al. device includes only the two layers 30A and 30B, the SUGIYAMA et al. device does not include an outer cover having three layers. Therefore, the SUGIYAMA et al. patent fails to disclose a flexible tube for an endoscope including, inter alia, “an outer cover which is provided over the core body” and which is “formed into a laminate structure composed of at least three layers, the layers of the laminate structure including an inner layer, an outer layer and at least one intermediate layer formed between the inner layer and the outer layer, wherein the intermediate layer of the outer cover has a higher elasticity than the inner and outer layers so that the intermediate layer functions as cushioning between the inner layer and the outer layer”, as set forth in claim 2.

Moreover, in the SUGIYAMA et al. device, the layer 30A does not function “as cushioning between the inner layer and the outer layer” as recited in claim 2. In particular, the materials of the layers 30A and 30B are chosen for their characteristics including slipping ability (see column 3, lines 9-25). SUGIYAMA et al. does not disclose any of the materials being chosen for their cushioning ability. Further, the inner layer as asserted by the Examiner is formed of material 30A within the mesh 21 of the reticulate tube 20 that has seeped into the mesh 21 while the layer 30A was molten and being formed. Therefore, the material 30A within the mesh 21 is in fact an extension of the layer 30A; and the layer 30A cannot logically act as “cushioning” with itself. Therefore, the SUGIYAMA et al. patent does not

disclose a flexible tube for an endoscope device including inter alia “an outer cover which is formed into a laminate structure composed of at least three layers” including inner, intermediate and outer layers in which “the intermediate layer of the outer cover has a higher elasticity than the inner and outer layers so that the intermediate layer functions as a cushioning between the inner layer and the outer layer” as recited in claim 2.

Since the reference fails to show each and every element of the claimed device, the rejection of claim 2 under 35 U.S.C. § 102(b) over SUGIYAMA et al. is improper and withdrawal thereof is respectfully requested.

Applicants also submit that dependent claims 3, 5, 8-14, and 16-21, which are at least patentable due to their dependency from claim 2 for the reasons noted above, recite additional features of the invention and are also separately patentable over the prior art of record.

Accordingly, Applicants respectfully request reconsideration and withdrawal of all the rejections, and an early indication of the allowance of claims 2-14 and 16-21.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, considered alone or in any proper combination thereof, anticipate or render obvious Applicants' invention as recited in claims 2-14 and 16-21. The applied references of record

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have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Final Official Action and allowance of all of the claims in the present application are respectfully requested and now believed to be appropriate.

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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